



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

05 MAR 2008

BARNES & THORNBURG LLP
P.O. BOX 2786
CHICAGO, IL 60690-2786

In re Application of FRISKNEY et al
U.S. Application No.: 10/593,108
PCT Application No.: PCT/GB2005/001332
Int. Filing Date: 06 April 2005

Priority Date Claimed: 06 April 2004

Attorney Docket No.: 920476-104020

For: DIFFERENTIAL FORWARDING IN
ADDRESS-BASED CARRIER NETWORKS

DECISION

This is in response to applicant's "Change of Inventorship Pursuant to 35 C.F.R. § 1.497(d)" filed 26 December 2007.

BACKGROUND

On 06 April 2005, applicant filed international application PCT/GB2005/001332, which claimed priority of an earlier United States application filed 06 April 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 20 October 2005. The thirty-month period for paying the basic national fee in the United States expired on 06 October 2006.

On 15 September 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 16 April 2007, applicant filed executed declarations.

On 11 May 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that the declaration filed 16 April 2007 omitted an inventor who was listed in the published international application.

On 21 May 2007, applicant filed a response to the Notification of Missing Requirements.

On 20 November 2007, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that applicant's 21 May 2007 response did not address the defect indicated in the Notification of Missing Requirements.

On 26 December 2007, applicant filed the present petition under 37 CFR 1.497(d).

DISCUSSION

The petition states that Mark Gibbon should be deleted as an inventor.

37 CFR 1.497(d) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

With regard to item (1) above, the requisite statement has been provided.

With regard to item (2) above, the requisite processing fee has been provided.

With regard to item (3) above, the petition includes a statement of written consent from the purported assignee Nortel Networks Limited ("Nortel"). The statement of consent either (1) is not signed by a person with apparent authority to sign on behalf of the assignee or (2) does not set forth that the person signing is authorized to act on behalf of the assignee. See MPEP 324, Section V. Furthermore, Nortel has not established ownership of the application in accordance with 37 CFR 3.73(b)(1). Although the petition states that a copy of an assignment document was previously filed, the application file contains no such assignment document.

With regard to item (4) above, no new oath or declaration is required by 37 CFR 1.497(f).

CONCLUSION

For the reasons above, the petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303

Facsimile: 571-273-0459